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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,372	05/31/2001	Shinobu Sato	14672	1758

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EXAMINER
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LU, TOM Y

ART UNIT	PAPER NUMBER
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2621

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/871,372	<b>Applicant(s)</b> SATO, SHINOBU	
	<b>Examiner</b> Tom Y. Lu	<b>Art Unit</b> 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-23 is/are allowed.
- 6) ☒ Claim(s) 24 is/are rejected.
- 7) ☒ Claim(s) 25-27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment and written response filed on 10/19/2004 has been entered.
2. Claims 1 and 11 have been amended.
3. Claims 24-27 are newly added.
4. Claims 1-27 are pending.

### ***Response to Arguments***

5. Applicant's arguments, see Remarks pages 8-9, filed 10/12/2004, with respect to claim 11 have been fully considered and are persuasive. The rejection of claim 11 has been withdrawn.

### ***Claim Objections***

6. Claim 11 is objected to because of the following informalities: a typographical error is found. In line 7, it should be "a number N3 of times". Appropriate correction is required.
7. Claim 24 is objected to because of the following informalities: a typographical error is found. The applicant is advised to delete one of "into the first data". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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8. Claim 24 is rejected under 35 U.S.C. 102(e) as being anticipated by Rhoads (U.S. Patent No. 6,345,104 B1).

Referring to Claim 24, Rhoads discloses a method of inserting second data into first data (Rhoads discloses a watermarking operation, which encodes watermark information, the second data, into an image, the first data, column 25, line 3), said method comprising: inserting the second data into the first data at a predetermined insertion degree so as to create third data (watermark information is encoded into an image to create encoded bits, column 25, lines 4-5, at a predetermined insertion degree, the degree of detect-ability in the existing encoding operation is the claimed “predetermine insertion degree”, column 25, line 1); selecting either the first data or third data; counting a number NA of times selection is made at said selecting and a number N3 of times the third data is selected; and adjusting the insertion degree, based on at least one of the numbers NA and N3 counted at said counting (Rhoads teaches a re-watermarking operation at column 25, line 3, to adjust some of the encoded bits in order to make the encoded data equally detectable from the encoded object, column 25, lines 17-18, the “equally detectable” is the claimed “adjusted insertion degree”. Such re-watermarking operation requires counting of all the bits in the image, the object, in order to ensure all the encoded bits are detected, and these encoded bits are compared to determine the ones that are more robust than others, column 25, lines 4-10. And counting of all the bits in the image is the claimed “counting a number NA of times selection is made at said selecting”. And the number of the encoded bits are also counted because ensuring the encoded data are approximately equally detectable requires averaging the signal-to-noise ratio for each encoded bit, column 25, line 17, and an averaging process require the number of the encoded bits to be counted. Therefore, it is apparently that adjusting the

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insertion degree, making the encoded data equally detectable, requires at least the number of the encoded bits).

*Allowable Subject Matter*

9. Claims 1-23 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

- a. Claims 1-10 are allowed as indicated on the previous office action dated 7/15/2004.
- b. Claim 11 is allowed based on the convincing argument presented in the Remarks dated 10/12/2004, and the searched prior art fails to teach the allowable features of a counter for counting a number NA of times selection is made in said selection circuit and a number N3 of times the third data is selected; and an adjustment circuit for adjusting the insertion degree based on the numbers of NA and N3 counted by said counter.
- c. Claims 12-23 are dependent upon Claim 11.

10. Claims 25 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Y. Lu whose telephone number is (571) 272-7393. The examiner can normally be reached on 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on (571) 272-7453. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tom Y. Lu



JOSE L. COUSO  
PRIMARY EXAMINER